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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/868,200 06/03/97 GARBER

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EXAMINER

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PATEL, J

ART UNIT	PAPER NUMBER
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2765

7

DATE MAILED: 08/18/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 08/868,200	Applicant(s) Howard B. Garber
	Examiner Jagdish Patel	Group Art Unit 2765

Responsive to communication(s) filed on May 26, 1998

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claim

Claim(s) 1-21 and 23-55 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) 14-21 is/are allowed.

Claim(s) 1, 2, 8-13, and 23-55 is/are rejected.

Claim(s) 3-7 is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This communication is in response to applicant's amendment filed on 5-21-98.
2. In response to applicant's amendment filed on 5-21-98, all requested changes to specification except indicated below have been entered:

page 11, line 19, after "PMM" and before "44" insert --computer's--. Reason: line 19 does not contain "44".

Please clarify this change.

3. Claim 22 has been canceled.
4. Amendments to claims 1-2, 5, 13-17, 23-34, 37-41, 45, 49 and 51 have been entered.
5. Claim 22 has been deleted. New claims 52-55 have been added.
6. The drawings including the changes requested by the examiner in earlier office action have not been reviewed since exhibit A attached to the amendment was not found.
7. The objections to the specifications for various informalities, with respect to claims 8-12 and claims 17, 24, 34, 37-48 and 51 have been withdrawn in response to correction of informalities cited in previous office action.

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8. Due to the amendments to claims and in view of the explanation given in the amendment the claim rejections under 35 USC § 112 to claims 1-23 and 28-33 have been withdrawn with the following exceptions:

claim 13: objected to because the phrase "...can be traded.." is vague and indefinite. Appropriate correction is required.

9. Amendments to claims 34-51 rejections do not overcome 35 USC § 101 rejections for the following reasons and the subject claims stand rejected :

the process step of "providing a ...computer" is interpreted as a manual step having no structural relationship with other process limitations ("receiving.., storing..., executing...etc.). Additionally the terms "automatically" or "transmitting" by themselves with broad and reasonable interpretation do not place the claimed invention in technological art and therefore the claimed invention is rendered non statutory under 35 USC § 101.

The above analysis also applies to new claims 52-55 and accordingly these claims are rejected on the same grounds.

The examiner suggests the following exemplary remedy (applied to claim 37) to place the claims in statutory guidelines:

amend the claim to read ..."A computerized method [of] having a principal market maker computer for maintaining....comprising the steps of:

[providing a principal market maker computer;]

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receiving in the principal market maker computer a ....

automatically matching..

10. The applicant's arguments regarding Claims 1-7, 13,24,25,33 and 49-51 rejections under 35 USC §102(b) over Sibley '552 and claims 14-51 rejections under 35 USC §102(b) over Wiseman '446 cited in prior office action are convincing and the rejections are accordingly withdrawn.

11. The applicant's arguments regarding Claims 8-12 rejections under 35 USC §103(a) over Sibley '552 cited in prior office action are convincing and the rejections are accordingly withdrawn.

### ***Claim Objections***

12. Claim 13 is objected because the phrase "can be" renders the claim vague and indefinite. Appropriate correction is required.

Claim 27 and its dependent claims are objected to because of the following informalities: per amendment claim 27 is dependent on itself. This appears to be a typographical error. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 26-32 recites the limitation ""the electronic bank and institutional market" in claims 26-32. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,2,13,24,33,49,50 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wagner (US Pat. 4,903,201) hereafter referred to as Wagner.

Claim 1: Wagner discloses an automated futures trading exchange system comprising:

an electronic brokerage and trading network having at least one computer, display terminal and input, the electronic brokerage and trading network operative to receive and transmit bids and offers for trading commodities (fig. 1 remote terminal 18 including modem 32 communicating to/from the central trade exchange trading system trading network connects at least one computer terminal 18 to a trading network, receives and transmits bids/offers, see listed functions of trading system 12 in fig. 1, also see col. 1 lines 15-37); and

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a principal market maker computer coupled to the electronic brokerage and trading network, the principal market maker computer operative to receive and transmit bids and offers automatically execute commodity trades to maintain bid and offer market for such commodity (see fig. 1 central trade exchange which incorporate a central processor 13 performing the claimed functions for commodity contracts, see listed functions performed by the processor. See col. 4 lines 3-22 which describe the function of the computer).

Claim 2: the system further comprising a clearing facility for processing trades executed by the principal market maker computer (fig. 1, item 38 clearing system, col. 4 lines 54-59, col. 7 lines 40- col. 8 line 16).

Claim 13: see claim 1. This claim does not limit the claim with a means language.

Claim 24: all limitations are analyzed in claim 1.

Claim 25: all limitations are analyzed in claim 2.

Claim 33: all limitations are analyzed in claim 1.

Claim 49: all limitations are analyzed in claim 1.

Claim 50: method of claim 49 further comprising the step of confirming and setting said matched trades (col. 8 lines 38-53).

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***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wagner (U.S. Pat. 4,903,201).

9. Claim 8-12: Wagner does not clearly teach connecting the trading system to various networks recited in these claims.

Official Notice is taken that the trading networks recited in the subject claims are well known in art of commodity (including currency) trading as is also recited in the disclosure of the instant application (p. 8).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to link the trading system of Wagner to one or more trading networks in order that the trading time period and coverage is expanded.

All other limitations of claims 8-12 are analyzed in claim 1.

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***Allowable Subject Matter***

10. Claims 3-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14-21 are allowed.

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***Contact Information***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached on Monday-Friday from 7.30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached on (703) 305-9708. The fax phone number for this Group is (703) 305-3988.

J Patel

08/13/98



ALLEN R. MACDONALD  
SUPERVISORY PATENT EXAMINER